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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/004,737 01/09/98 BURBANK

EXAMINER

QM41/0717

DONALD E STOUT
PETERSON UXA AND STOUT
100 PACIFICA SUITE 210
IRVINE CA 92618

ART UNIT	PAPER NUMBER
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HINDENBURG, M

DATE MAILED:

07/17/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 1/9/98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 47-60 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☒ Claim(s) 47-60 is/are allowed.
☒ Claim(s) 1 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 3736

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,526,822. This is a double patenting rejection.

3. Claims 47-60 are allowable over the art of record which do not show a biopsy instrument for obtaining multiple samples of tissue comprising a housing, a needle being rotatable and having a tissue receiving port for being positionable at multiple angular positions about the longitudinal axis of the needle for sequentially obtaining multiple samples, and a cutter.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The "Core Tissue Biopsy" article was not considered as it had no publication date and patent no. 4,735,245 was not considered as the inventor was not Goto et al. and the patent was not medically related.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Max Hindenburg, A.U. 3736, whose telephone number is (703)308-3130.

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The supervisor for A.U. 3736 is Jennifer Bahr whose telephone number is (703)308-1066. The FAX No. for Sector 3700 is (703)305-3590.

MH

July 15, 1998



Max Hindenburg
Primary Examiner